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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/998,360

11/29/2001

Rowan Bosworth-Davies

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04/10/2007

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/998,360	Applicant(s) BOSWORTH-DAVIES ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 11/16/2006.

Response to Amendment

2. Claims 1, 22, 43 and 65 have been amended and new claims 66 and 67 have been added.

Upon further consideration the previously allowed claims have been rejected based on new grounds of rejection. This office action accordingly is made a non-final action.

Claim Rejections - 35 USC § 112

3. Claims 43 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 43: The limitation "applying a weighting function to the outcome of running each rule according to the importance of the rule to the potential for a financial irregularity being present in the transaction" is vague and unclear because the limitation does not specify what happen as a result of applying a weighing function. The limitation also recites that the weighing function is applied to the outcome of running each rule without specifying such outcome (previous limitations do not account for "importance of the rule"). The limitation also recites that the weighing function is applied to the outcome of running each rule ..then "to the potential for a financial irregularity". This renders the claim limitation unclear the term "the potential" is not recited as "the outcome indicative of the potential".

Claim 65 corresponds to claim 43 and contain similar defects.

Claim Rejections - 35 USC § 103

4. Claims 1, 3-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 2002/0099649) (hereafter referred to as Lee).

As per claim 1 Lee teaches a system for identifying a potential for financial irregularities in a financial transaction (see abstract), which system comprises a first database for storing at least one transaction and for containing information related to at least one client and at least one account of said at least one client upon which said at least one transaction can be effected;

(see Figure 1 block 1 106, "out-sorted orders 106 are stored in a file system (and may be sequenced for handling" [0076])

a processor loaded with a rules engine. including a predetermined set of predetermined rules said predetermined rules being selectable from a set of rules available for selection by an institution responsible for said first database, said predetermined set of predetermined rules to apply to said at least one transaction for determining a potential for the presence of financial irregularity in said at least one transaction, the processor being operable to access the data in the database to run the predetermined set of rules in respect of the data and to produce an outcome indicative of the potential for a financial irregularity being present in the at least one transaction.

(see Figure 1, block 112 and [0068] "The rule engine 112 implements various rules 108 that establish its policies for dealing with fraudulent or potentially fraudulent transactions."

See ([0075] The merchant defines rules 108 ...The PMW allows the merchant to define, edit, delete any rules it desires.).

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Lee teaches a processor that is operable to produce numerical outcome for each rule that is transgressed by the transaction, (see [0066], [0342] "scoring model 316").

However, Lee fails to teach that the processor loaded with the rule engine as stated in the claim also operable to produce numerical outcome for each rule that is transgressed by the transaction.

However, it has been established by the courts that combining functions of two components of a device into a single component is within skill of an ordinary artisan who is skilled in the art.

In re Wolfe, 116 USPQ 443, 444 (CCPA 1961)) "It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable."

In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.").

It would have been obvious to one of ordinary skill in the art to have the processor of Lee loaded with a rule engine as stated above also be operable to produce the numerical outcome for each rule that is transgressed by the transaction because it would accomplish the same functionality as the claimed invention and that it would be a design choice of one skilled in the art.

Claims 3-5: set of rules includes a first (a second, a third) group of rules ..

(see [0217] five different rule basis 403 used by the rule engine]

Claim 6: the processor is operable to combine the outcomes of running at least a selection of the rules in the set to produce an overall outcome indicative of the potential for a financial irregularity.

(see [0075] note that the fraud score is generated from the merchant selected rules, see also [0109] and [0342])

Claim 7 and 15: the processor is further operable to apply a weighting function to the outcome of running each rule according to the importance of the rule

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to the potential for a financial irregularity being present in the transaction. .. a further weighting function is applied to a predefined collection of rules which are transgressed in respect of the same or related transactions.

(see [109], [0126] and Claim 1.)

Claim 9: user input means for disabling at least one input means. (see claim 1 analysis)

claims 10 and 11: the processor includes a routine for applying a threshold value to each outcome, which routine is arranged to generate an output of transgression of the rule if the threshold is crossed.

..applying a threshold value to the overall outcome..

([0343] A primary output of the eFalcon system 100 is the fraud score that measures the likelihood that each order is fraudulent. In one embodiment, the merchant may create a rule that sets a threshold, or "cutoff score," above which all orders are rejected. The merchant might then create a different rule, with a lower threshold score, "outsort score," for which all orders receiving scores above that threshold and less than the first are flagged for further investigation.).

Claims 11-12: the processor includes a routine for applying a threshold value to the overall outcome, which routine is arranged to generate an output indicating the potential for a financial irregularity being present if the threshold is crossed.

([0368], threshold values)

Claim 13. (Original) The system of claim 12 including art archive for storing the transaction data, the processor means being arranged to access the archive to establish the said pattern based on previous related transactions.

([0044] and [0045])

Claim 14: set of rules includes rules corresponding to client, account and transaction information, the set of rules being selected from the group..

(see [0205] and [0206], note that a set of rules may include at least two rules).

Claim 16-18: limitations are explicitly disclosed in the cited prior art (see Fig. 1).

Claim 19-21. the outcome is translated into a user alert indicative of the potential for the presence of a financial irregularity in the transaction (see Fig. 4, message 405).

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All limitations of method claims 22-42 have been analyzed as per respective apparatus claims. 1-21 .

All limitations of method claim 43 have been analyzed as per apparatus claims 22-42.

All limitation of computer-readable medium claims 44-64 have been analyzed per respective method claims.

All limitation of computer-readable medium claims 65-67 have been analyzed per respective method claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

12/18/06